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09/994,163	11/26/2001	Richard Louis Herrmann	HERRMANN 1-1-3	9617

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EXAMINER

DUONG, FRANK

ART UNIT

PAPER NUMBER

2666

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Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,163	<b>Applicant(s)</b> HERRMANN ET AL.	
	<b>Examiner</b> Frank Duong	<b>Art Unit</b> 2666	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-22 is/are rejected.
- 7) ☐ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is a response to communications dated 11/26/01. Claims 1-22 are pending in the application.

### ***Claim Objections***

2. Claims 2-5, 8-9, 12 and 16 are objected to because of the following informalities:

Claim 2:

Line 1, "apparatus," should read --apparatus for,--.

Line 5, "the associated call connection" should change to --an associated call connection--.

Claim 3, line 1, "apparatus," should read --apparatus for,--.

Claim 4, line 2, "apparatus," should read --apparatus for,--.

Claim 5:

Lines 3 and 4, the term "may be" should be replaced with --is--.

Line 3, "second caller" should read --second user--.

Line 4, the term "other apparatus" should be replaced with --a third apparatus--.

Claim 8:

Line 2, "apparatus," should read --apparatus for,--.

Line 3, the term "may be" should be replaced with --is--.

Claim 9, line 2, "apparatus," should read --apparatus for,--.

Claim 12, line 4, apparatus" should read --an apparatus--.

Claim 16, line 3, "the request" should read --a request--.

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Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 5 and 6, "said apparatus" recited on line 4 and line 2 of claims 5 and 6, respectively, is vague. It is unclear what apparatus "said apparatus" refers to.

Claims 7-10 variously depend from their indefinite parent claim 5.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 12-22 are rejected under the judicially created doctrine of obviousness-type

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double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,335,928. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-9 of patent '928 teaches essentially the same elements as claims 12-22 of the current application. Even though claims 12-22 are broadened by omitting certain limitations (i.e., "*interfacing with a caller*" and "*identified by the caller using the converted text*" in claim 12; "*the user to state verbally*" in claim 18), it has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPT 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwami et al (USP 5,604,737) (hereinafter "Iwami").

Regarding **claim 1**, in accordance with Iwami reference entirety, Iwami shows a service platform (*Fig. 1; 20 or Fig. 2 and col. 7, lines 1-47*) connected to the Internet (1) (*note: packet switching discussed at col. 1, line 24 is equated to correspond to Internet*) and to a telecommunications network (3) comprising:

first apparatus (14) for interfacing said service platform with the Internet (1) so that a first user (10-1 or 10-2) may access the telecommunications network (3) via the Internet (1), and

second apparatus (11 and 16) for interfacing said service platform with the telecommunications network (3) so that a second user (2) may access the Internet (1) via the telecommunications network (3).

Regarding **claim 11**, in addition to features recited in base claim 1 (see rationales discussed above), Iwami further shows wherein said telecommunications network is a public switched telephone network (3).

6. Claims 12-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Freishtat et al (USP 5,945,989) (hereinafter "Freishtat").

Regarding **claim 12**, in accordance with Freishtat reference entirety, Freishtat discloses a service platform (*Fig. 16; Call Processing System*) comprising:

an apparatus for receiving a connection (T1 CARD) from a station telephone (TELEPHONE) and for obtaining updated information via the connection (*col. 4, line 64 to col. 5, line 2 and thereafter*), and

an apparatus for converting (Fig. 16; 206 or Fig. 15) the update information directly into a corresponding format and for updating a Web page in a manner identified by the corresponding formalized information (*Dispatcher 206 is discussed at col. 11, line 24 to col. 12, line 65 and services to include TTS (text-to-speech) is discussed at col. 12, lines 52-54 to enable users without programming background to create and modify web pages (abstract, col. 5, lines 3-10 and thereafter)*).

Regarding **claim 13**, in addition to features recited in base claim 13 (see rationales discussed above), Freishtat further discloses wherein said update information is uttered by a caller and wherein said apparatus includes voice conversion apparatus (IVR) for converting said uttered instructions into text for insertion in said Web page (*col. 5, lines 1-15 or col. 9, lines 36-50 and thereafter*).

Regarding **claim 14**, in addition to features recited in base claim 13 (see rationales discussed above), Freishtat further discloses wherein said converting apparatus includes apparatus for transmitting to said caller over the connection a verbal rendition (*user is read back*) of the converted text (*col. 10, line 14 and thereafter*).

Regarding **claim 15**, in addition to features recited in base claim 14 (see rationales discussed above), Freishtat further discloses wherein said converting apparatus includes apparatus, responsive to receipt of an indication from said caller that the verbal rendition is correct, for forwarding (committing or discarding) the converted text to a Web server to update the identified Web page (*col. 10, lines 15-16*).

Regarding **claim 16**, in addition to features recited in base claim 14 (see rationales discussed above), Freishtat further discloses wherein said converting apparatus includes apparatus, responsive to receipt of an indication from said caller that the verbal rendition is incorrect, for forwarding the request to the caller to repeat said update information (*col. 10, lines 14-16 and thereafter*).

Regarding **claim 17**, in addition to features recited in base claim 14 (see rationales discussed above), Freishtat further discloses wherein said converting apparatus further includes apparatus, operative when said Web page has been successfully updated for so notifying said caller (user is read back) (*col. 10, lines 14-16 and thereafter*).

Regarding **claim 18**, in accordance with Freishtat reference entirety, Freishtat further discloses a method (*CT/I Service discussed at col. 9, line 36 and thereafter*) for processing Web page content editing via a communications connection, said method comprising the steps of:

establishing a communications connection (*col. 9, lines 37-38, user call their application's 800 number to perform Web update*);

prompting for content that is to be inserted in the Web page (*col. 9, lines 40-42 and thereafter, user will be asked to select a web page to update with new content*);

receiving the content (*col. 9, lines 43-45, user will select what the user wants to update to include audio, graphic or HTML code*);

recognizing the content and converting the content into text (*col. 9, lines 46-47, if audio need to be updated user will speak his or her message. Moreover, at col. 5, line*



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*6 and thereafter, it is disclosed voice messages are recorded, encoded and posted to the appropriate directory on the Web server and text-to-speech service is discussed at col. 12, lines 51-53 and thereafter); and*

*changing the Web page content using the converted text (col. 10, line 20 to col. 11, line 9, it is disclosed the Publisher to include reads and rewrite the web page with the new content).*

Regarding **claim 19**, in addition to features recited in base claim 18 (see rationales discussed above), Freishtat further discloses wherein said content is a verbal instruction uttered by a user (*col. 9, lines 46-47, user will speak his or her message*).

Regarding **claim 20**, in addition to features recited in base claim 19 (see rationales discussed above), Freishtat further discloses wherein said step of recognizing uses an automatic speech recognition module (VCS) to convert said verbal instruction into text (*CT/I service is discussed at col. 9, line 36 to col. 10, line 16 with the hardware and software provides the ability to include automatic speech recognition as well as text-to-speech at col. 20, lines 9-23*).

Regarding **claim 21**, in addition to features recited in base claim 18 (see rationales discussed above), Freishtat further discloses wherein said content is provided utilizing a facsimile transmission over said communications connection (*CT/I service is discussed at col. 9, line 36 to col. 10, line 16 with the hardware and software provides the ability to include faxes at col. 20, lines 9-23*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freishtat in view of Penner et al (USP 5,793,762) (hereinafter "Penner").

Regarding **claim 22**, in addition to features recited in base claim 18, Freishtat fails to explicitly disclose wherein said content is provided utilizing a portable wireless data device. In Freishtat the content is provided using a conventional telephone, instead of the portable wireless data device. However, such limitation lacks thereof from Freishtat is well known in the telecommunications and disclosed by Penner.

In accordance with Penner reference entirety, Penner discloses a system and method for providing data and voice services subscribers having an existing wireline switch (PSTN) comprising, among other things, a radio port controller architecture (Fig. 1) having a radio port controller (20), a radio port (18) and a portable wireless data device (16) to provide users with wireless services with minimal impact or upgrade to the existing switches or PSTN network ('762, col. 2, lines 41-50).

Thus, it would have been obvious to those skilled in the art at the time of the invention was made to replace Freishtat's conventional phone with Penners' radio port controller architecture to arrive the claimed invention with a motivation to provide users

with wireless services with minimal impact or upgrade to the existing switches or PSTN network ('762, col. 2, lines 41-50).

***Allowable Subject Matter***

8. Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 5-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
10. The following is a statement of reasons for the indication of allowable subject matter:  
The prior art of record, considered individually or in combination, fails to fairly show or suggest the claimed invention of base claim 1 and further limit with novel and unobvious limitations in a manner as recited in the dependent claims 2-10.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gordon (USP 5,608,786).

Noonen et al (USP 5,761,280).

Wise et al (USP 5,884,262).

Rhie et al (USP 5,953,392).

Uppaluru (USP 5,915,001).

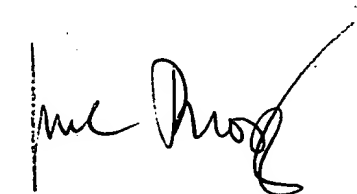
Lin (USP 6,285,683).

Low, The Internet Telephony Red Herring, Hewlett-Packard Laboratories, pages 1-15, May 15, 1996.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Frank Duong', with a vertical line to the left of the first name.

**FRANK DUONG**  
**PRIMARY EXAMINER**

August 30, 2005